

## **REMARKS**

Applicant would like to thank the Examiner, Mr. Grosso, and his supervisor for the telephone interview which occurred on Tuesday October 17, 2006. All pending claims were discussed.

Applicant has withdrawn claims 5, 13, 14, 18 and 23 in response to the Examiner's restriction requirement. However, should claims 1 and 4, as originally filed, be allowed, dependent claims 5, 13 and 14 should be reinstated because they are dependent from a generic allowed claim. Similarly, should independent claim 16, as originally filed, be allowed, dependent claims 18 and 23 should be reinstated because they depend from a generic allowed claim. Applicant has cancelled claims 7, 8, 11, 20-22, 26, 28-35 and 38-44. Applicant has added new claims 45-55.

The Examiner objected to the drawings under 37 CFR 1.83(a). Applicant has cancelled claims 7, 8, 11, 20-22 and 26. Therefore, the Examiner's objection is moot.

The Examiner rejected claims 7, 8, 20, 21 and 22 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Claims 7, 8, 20, 21 and 22 have been cancelled. Therefore, the Examiner's rejection is moot.

The Examiner rejected claims 1, 3, 4, 15, 16 and 17 under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,725,118 issued to Slager et al. in view in U.S. Patent No. 5,320,244 issued to Yu. Applicant traverses this rejection for the following reasons.

First, the Examiner has not established a prima facie case of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument. Id. If

examination at the initial stage does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. Id. A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art at the time of the invention. In re Bell, 991 F.2d 781, 782, 26 USPQ2d. 1529, 1531 (Fed. Cir. 1993).

To properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the references. See e.g. ACS Hospital Systems Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983); and In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999).

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate a frame defining the horizontal opening of the container. Without such a teaching suggestion or inference in the Slager et al. patent, the combination of references used by the Examiner is improper.

The Yu patent actually teaches away from the Slager et al. patent. The purpose of the retaining frame 40 in Yu is to retain the storage assembly 30 in the housing 20. See Yu, column 4, lines 40-46. In the Slager et al. container 10, two injection molded plastic sidewalls 14a, 14b, each having wrap around segments with lateral edges 59 which engage adjacent grid portions 60 to laterally contain the product grids 30, 42 and prevent them from shifting with the container body in the direction of the open sides 18, 19. See Slager et al, column 6, line 60 to column 7 line 1. Thus, there is no need for a rectangular frame like the one shown in Yu to be

used with the Slager et al. container because the dunnage or product grids of Slager et al. are already contained within the container due to the wrap around segments of the injection molded plastic sidewalls 14a, 14b.

Furthermore, if one were to incorporate a frame like the one shown in Yu into the Slager et al. container, it would destroy the purpose of the Slager et al. container. As stated in column 2, lines 40-43 of Slager et al., the Slager et al. container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is clearly shown in Fig. 3 of Slager et al. Thus, it is impossible to modify the alternative embodiment of Slager et al. shown in Fig. 3 to add a frame as the Examiner suggests in his rejection. When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992).

The combination of references is further improper because the Examiner has simply used applicant's claim as a blueprint to abstract bits and pieces of the prior art together, through hindsight to make the above obviousness rejection. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. In re Rinehart, 189

USPQ 143 (CCPA 1976); In re Regal, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the cited pieces of prior art to create the combinations upon which he rejected the claims of the application. This was error as a matter of law. W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

The Examiner rejected claim 2 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of U.S. Patent No. 6,827,231 issued to Budowski et al. Applicant traverses this rejection for the same reasons stated above with regard to Claim 1.

The Budowski et al. patent is directed to non-analogous art (minivan box liners) and teaches away from Slager et al. patent. In the Slager et al. container 10, two injection molded plastic sidewalls 14a, 14b, as well as sidewalls 14c, 14d which may be added, each of which may be hinged to base 12. See Slager et al, column 7, lines 10-27. Thus, a sleeve made of one piece of material like the one shown in Budowski et al. could not be used with the Slager et al. container because the sidewalls 14c, 14d of Slager et al. could not be removed from the container.

Furthermore, if one were to incorporate a one-piece sleeve into the Slager et al. container, it would destroy the purpose of the Slager et al. container. As stated in column 2, lines 40-43 of Slager et al., the Slager et al. container (including the alternative embodiment of container shown in Fig. 3 having three sidewalls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge

structure 62 is clearly shown in Fig. 3 of Slager et al. Thus, it is impossible to modify the Slager et al. container so as to have a one-piece sleeve.

The Examiner rejected claims 6, 8 and 19-21 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of U.S. Patent No. 6,540,096 issued to Bazany et al. Claims 8, 20 and 21 have been cancelled. Regarding the rejection of claims 6 and 19, Applicant traverses this rejection for the same reasons stated above with regard to Claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate dunnage comprising pouches. Without such a teaching suggestion or inference in the Slager et al. patent, the combination of references used by the Examiner is improper.

The Examiner rejected claim 7 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and Bazany et al. and further in view of U.S. Patent No. 2,608,339 issued to Benzon-Peterson. This rejection is moot because claim 7 has been cancelled.

The Examiner rejected claims 9-11 and 24-26 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of U.S. Patent No. 4,828,132 issued to Francis, Jr. et al. Claims 11 and 26 have been cancelled. Regarding the rejection of claims 9, 10, 24 and 25, applicant traverses this rejection for the same reasons stated above with regard to Claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container to incorporate a sleeve made of corrugated plastic wherein the corrugations extend vertically. Without such a teaching, suggestion or inference in the Slager et al. patent, the combination of references used by the Examiner is

improper.

The Examiner rejected claim 12 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of U.S. Patent No. 1,163,696 issued to Silberman. Applicant traverses this rejection for the same reasons stated above with regard to Claim 1.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claim 22 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and Benzon-Peterson. This rejection is moot because claim 22 has been cancelled.

The Examiner rejected claim 27 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of Silberman. Applicant traverses this rejection for the same reasons stated above with regard to Claim 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate fasteners for securing a sleeve to the pallet base. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

The Examiner rejected claims 36 and 37 under 35 USC 103(a) as being unpatentable over Slager et al. in view in Yu and further in view of Francis, Jr. et al. Applicant traverses this rejection for the same reasons stated above with regard to Claims 1 and 16.

Applying the law to the facts of the instant case, there is no teaching, suggestion or inference of modifying the Slager et al. container, as modified, to incorporate a pallet base and

pallet cover each having a lip. Without such a teaching, suggestion or inference in the Slager et al. patent, as modified, the combination of references used by the Examiner is improper.

If any charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000. If any questions remain, or the Examiner wishes to discuss this matter, a telephone call to undersigned would be greatly appreciated.

Respectfully submitted,

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